

REMARKS:

Claims 1-32 are currently pending in the application.

Claims 1, 2, 4, 6-13, and 16-32 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,484,149 to Jammes *et al.* ("*Jammes*").

Claims 3, 14, and 15 stand rejected under 35 U.S.C. § 103(a) over Jammes in view of U.S. Patent No. 5,758,328 to Giovannoli ("*Giovannoli*").

Claim 5 stands rejected under 35 U.S.C. § 103(a) over Jammes in view of U.S. Patent Application Publication No. 2005/0261983 to Etten *et al.* ("*Etten*").

A Final Office Action in the subject Application was mailed to the undersigned on 23 May 2006, which provides for a response period ending 23 August 2006. The Applicant filed an Amendment After Final on 5 July 2006. An Advisory Action was mailed to the undersigned on 24 July 2006. The Advisory Action stated that the Applicant's amendments filed on 5 July 2006 will not be entered because they raise new issues that require further consideration and/or search. (24 July 2006 Advisory Action, Page 1). The Applicant respectfully reiterates here the arguments set forth in the Amendment After Final filed on 5 July 2006, as if fully set forth herein.

By this Amendment, the Applicant has amended claims 1-7 and 9-32 to more particularly point out and distinctly claim the Applicant's invention. By making these amendments, the Applicant makes no admission concerning the merits of the Examiner's rejection, and respectfully reserve the right to address any statement or averment of the Examiner not specifically addressed in this response. Particularly, the Applicant expressly reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1, 2, 4, 6-13, and 16-32 stand rejected under 35 U.S.C. § 103(a) over *Jammes*.

Claims 3, 14, and 15 stand rejected under 35 U.S.C. § 103(a) over *Jammes* in view of *Giovannoli*.

Claim 5 stands rejected under 35 U.S.C. § 103(a) over *Jammes* in view of *Etten*.

Although the Applicant believes claims 1-32 are directed to patentable subject matter without amendment, the Applicant has amended claims 1-7 and 9-32 to more particularly point out and distinctly claim the Applicant's invention. By making these amendments, the Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 102(e), as set forth in the Office Action.

The Applicant respectfully submits that *Jammes* fails to disclose, teach, or suggest each and every element of claims 1, 2, 4, 6-13, and 16-32. The Applicant further respectfully submits that *Jammes* or *Giovannoli*, either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claims 3, 14, and 15. The Applicant still further respectfully submits that *Jammes* or *Etten*, either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claim 5. In addition, the Applicant respectfully submits that ***the amendments to independent claims 1, 10, 21, and 32 have rendered moot the Examiner's rejection of claims 1-32 and the Examiner's arguments in support of the rejection of claims 1-32***. The Applicant further submits that amended independent claims 1, 10, 21, and 32 in their current amended form contain unique and novel limitations that are not disclosed, suggested, or even hinted at in *Jammes*, *Giovannoli*, or *Etten*. Thus, the Applicant respectfully traverses the Examiner's obvious rejection of claims 1-32 under 35 U.S.C. § 103(a) over the proposed combination of *Jammes*, *Giovannoli*, or *Etten*, either individually or in combination.

Jammes Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims

For example, with respect to amended independent claim 1, this claim recites:

An **electronic commerce system applying dynamic database redirection**, the system comprising:

one or more **seller databases** including product data for one or more products;

a **global content directory server** coupled to the one or more seller databases, the global content directory server comprising:

a **seller selection interface** operable to **receive one or more seller requirements from one or more buyers coupled to the global content directory server**,

one or more **custom global content directories** generated by the global content directory server based on the one or more seller requirements received from the one or more buyers, **each of the one or more custom global content directories includes a plurality of product classes organized in a hierarchy**, each product class categorizing a plurality of products from one or more sellers **satisfying the one or more seller requirements received from the one or more buyers** and each product class associated with one or more attributes of the products categorized in the product class, at least one of the **product classes having one or more associated pointers that identify one or more seller databases associated with sellers satisfying the one or more seller requirements received from the one or more buyers**; and

a **search interface operable to communicate a search query to the one or more seller databases to search the product data stored in the one or more seller databases identified by one of the pointers**.
(Emphasis Added).

Amended independent claims 10, 21, and 32 recite similar limitations. *Jammes* fails to disclose each and every limitation of amended independent claims 1, 10, 21, and 32.

The Applicant respectfully submits that *Jammes* has nothing to do with amended independent claim 1 limitations regarding an “**electronic commerce system applying dynamic database redirection**” and in particular *Jammes* has nothing to do with amended independent claim 1 limitations regarding “one or more **seller databases** including product data for one or more products” or a “**global content directory server** coupled to the one or more seller databases”. In particular, the Examiner equates the “**global content directory server**” recited in amended independent claim 1 with “item 106” disclosed in *Jammes*. (23 May 2006 Final Office Action, Pages 2-3). However, “item 106” disclosed in *Jammes* merely access HTML template files which are stored on a separate computer storage media, and **does not include a “global content directory**

server” and is not coupled to or otherwise associated with one or more seller databases, as recited in amended independent claim 1. (Column 8, Lines 11-19). In contrast, the **“global content directory server”** recited in amended independent claim 1 is *inter alia* “coupled to the one or more seller databases”. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Jammes* and amended independent claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent claim 1 from *Jammes*.

The Applicant further respectfully submits that *Jammes* has nothing to do with amended independent claim 1 limitations regarding a **“global content directory server”** comprising *inter alia* a **“seller selection interface** operable to **receive one or more seller requirements from one or more buyers coupled to the global content directory server”**. In particular, the Examiner equates the **“seller selection interface”** recited in amended independent claim 1 with “an interface presented by the seller for selecting products by the buyer”, purportedly disclosed in *Jammes*. (23 May 2006 Final Office Action, Page 11). However, the “interface presented by the seller for selecting products by the buyer” purportedly disclosed in *Jammes* are merely icons 402 and 404, and **do not include seller selection interface or are not even related to receiving one or more seller requirements from one or more buyers coupled to the global content directory server**, as recited in amended independent claim 1. (Column 15, Lines 16-27). In addition, the Examiner stipulates “that selecting a product from the interface presented by the seller indicates selecting said seller by the buyer.” However, the Applicant respectfully submits that the Examiner has mischaracterized the limitations cited in amended independent claim 1. The Examiner’s stipulation appears to be equating that if a product is selected from a seller, then this is equivalent to selecting a seller by a buyer, this equation cannot be made. In contrast, the **“seller selection interface”** recited in amended independent claim 1 is an interface (i.e. a seller selection interface) that receives **“one or more seller requirements”** from **“one or more buyers”** who are **“coupled to the global content directory server”**. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Jammes* and amended independent claim 1 cannot be made. The Applicant further respectfully submits

that these distinctions alone are sufficient to patentably distinguish amended independent claim 1 from *Jammes*.

The Applicant still further respectfully submits that *Jammes* has nothing to do with amended independent claim 1 limitations regarding a “**global content directory server**” comprising *inter alia* “one or more **custom global content directories** generated by the global content directory server based on the one or more seller requirements received from the one or more buyers, **each of the one or more custom global content directories includes a plurality of product classes organized in a hierarchy**, each product class categorizing a plurality of products from one or more sellers **satisfying the one or more seller requirements received from the one or more buyers** and each product class associated with one or more attributes of the products categorized in the product class, at least one of the **product classes having one or more associated pointers that identify one or more seller databases associated with sellers satisfying the one or more seller requirements received from the one or more buyers**”. In particular, the Examiner equates **generating** one or more **custom global content directories** recited in amended independent claim 1 with the recorded shopping habits disclosed in *Jammes*. (23 May 2006 Final Office Action, Page 12). However, the recorded shopping habits disclosed in *Jammes* is merely for “monitoring the shopping behavior of consumers to gather traffic analysis” and **has nothing to do with** “one or more **custom global content directories** generated by the global content directory server”. (Column 4, Lines 19-27). In contrast, **generating** one or more **custom global content directories** recited in amended independent claim 1 is generated “by the global content directory server” and is “based on the one or more seller requirements received from the one or more buyers.” Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Jammes* and amended independent claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent claim 1 from *Jammes*.

The Applicant still further respectfully submits that *Jammes* has nothing to do with amended independent claim 1 limitations regarding a “**global content directory server**”

comprising *inter alia* a “**search interface operable to communicate a search query to the one or more seller databases to search the product data stored in the one or more seller databases identified by one of the pointers**”. In particular, the Examiner equates the “**search interface**” recited in amended independent claim 1 with the SQL commands disclosed in *Jammes*. (23 May 2006 Final Office Action, Page 3). However, the SQL commands disclosed in *Jammes* is merely a command to retrieve records, **but does not include a search query to the one or more seller databases**, as recited in amended independent claim 1. (Column 26, Lines 15-27). In contrast, the “**search interface**” recited in amended independent claim 1 communicates a “**search query to the one or more seller databases**” to “**search the product data stored in the one or more seller databases**” which are “**identified by one of the pointers**”. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Jammes* and amended independent claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent claim 1 from *Jammes*.

The Office Action Acknowledges that *Jammes* Fails to Disclose Various Limitations Recited in Applicant’s Claims

The Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that *Jammes* fails to disclose the emphasized limitations noted above in amended independent claim 1. Specifically ***the Examiner acknowledges that Jammes fails to disclose an “electronic commerce system applying dynamic database redirection” comprising the “generation one (or more) global content directories is based on the seller requirements received from the buyer”***. (23 May 2006 Final Office Action, Page 3). However, the Examiner asserts that the knowledge generally available to those of ordinary skill in the art at the time of the invention discloses the acknowledged shortcomings in *Jammes*. The Applicant respectfully disagrees. The Applicant respectfully traverses the Examiner’s assertions regarding the knowledge generally available to those of ordinary skill in the art at the time of the invention.

The Office Action has Failed to Properly Establish a *Prima Facie* case of Obvious over *Jammes*

The Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on *Jammes*. The Office Action has not shown the required teaching, suggestion, or motivation in this reference or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that “it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify *Jammes* **to include that said generation one (or more) global content directories is based on the seller requirements received from the buyer**”. (23 May 2006 Final Office Action, Pages 3-4). (Emphasis Added). The Applicant respectfully disagrees.

The Applicant further respectfully submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Jammes* or in knowledge generally available to those of ordinary skill in the art at the time of the invention. The Examiner asserts that the motivation to combine the references as proposed would be “because it would advantageously **allow to assess the popularity of the merchant’s website, as well as the popularity of particular sellers**.” (23 May 2006 Final Office Action, Page 4). (Emphasis Added). The Applicant respectfully disagrees and further respectfully requests clarification as to how the Examiner arrives at this conclusion. For example, how does “**include[ing] that said generation one (or more) global content directories is based on the seller requirements received from the buyer**” directly increase the “**popularity of the merchant’s website, as well as the popularity of particular sellers**” and to what extent does the Examiner purport that the “**popularity of the merchant’s website**” or the “**popularity of particular sellers**” applies to the subject Application. **The Applicant respectfully request the Examiner to point to the portions of *Jammes* or in knowledge generally available to those of ordinary skill in the art at the time of the invention which contains the teaching, suggestion, or motivation to combine these references for the for the Examiner’s stated purported advantage.** In particular, the Applicant respectfully request the Examiner to point to the portions of

Jammes or in knowledge generally available to those of ordinary skill in the art at the time of the invention which expressly states that **"include[ing] that said generation one (or more) global content directories is based on the seller requirements received from the buyer"** increases the **"popularity of the merchant's website"** and the **"popularity of particular sellers"**. The Applicant further submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the **prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the **Examiner has not adequately supported the selection and combination of Jammes or in knowledge generally available to those of ordinary skill in the art at the time of the invention to render obvious the Applicant's claimed invention.** The Examiner's conclusory statements that "it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Jammes to include that said generation one (or more) global content directories is based on the seller requirements received from the buyer" and that "because it would advantageously allow to assess the popularity of the merchant's website, as well as the popularity of particular sellers", **does not adequately address the issue of motivation to combine.** (23 May 2006 Final Office Action, Pages 3-4). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, **the Office Action fails to provide proper motivation for combining the teachings of Jammes or in knowledge generally available to those of ordinary skill in the art at the time of the invention,** either individually or in combination.

The Proposed *Jammes-Giovannoli* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Dependent Claims 3, 14, and 15

For example, with respect to amended dependent claims 3 and 14, these claims recite:

3. The system of Claim 2, further operable to:
determine a geographic location for the one or more buyers and one or more languages that correspond to the geographic location of the one or more buyers; and
generate custom global content directories where the **pointers identify seller databases in the languages corresponding to the geographic location of the one or more buyers.** (Emphasis Added).

14. (Currently Amended) The method of Claim 10, further comprising **providing multi-language support based upon the geographic location of the one or more buyers.** (Emphasis Added).

Amended dependent claims 15, 25, and 26 recite similar limitations. *Jammes* or *Giovannoli*, either individually or in combination, fail to disclose each and every limitation of amended dependent claims 3, 14, 15, 25, and 26.

The Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that *Jammes* fails to disclose the emphasized limitations noted above in amended dependent claim 3. Specifically the Examiner acknowledges that *Jammes* fails to disclose an “**electronic commerce system applying dynamic database redirection**” further operable to “**determine a geographic location for the one or more buyers and one or more languages that correspond to the geographic location of the one or more buyers**”. (23 May 2006 Final Office Action, Page 9). However, the Examiner asserts that the cited portions of *Giovannoli* disclose the acknowledged shortcomings in *Jammes*. The Applicant respectfully disagrees. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in *Giovannoli*.

The Applicant respectfully maintains that *Giovannoli* has nothing to do with the amended dependent claim 3 limitations regarding an “**electronic commerce system applying dynamic database redirection**” and in particular *Giovannoli* has nothing to

do with amended dependent claim 3 limitations regarding the electronic commerce system operable to “**determine a geographic location for the one or more buyers and one or more languages that correspond to the geographic location of the one or more buyers**”; and generate custom global content directories where the **pointers identify seller databases in the languages corresponding to the geographic location of the one or more buyers**.” Rather, *Giovannoli* describes an approach for processing requests for quotation through a central processing unit. (Abstract). The Applicant directs the Examiner’s attention to the cited portions of *Giovannoli*, relied upon by the Examiner:

The RFQ is then processed to select vendors who are capable of quoting on the RFQ and who meet any other conditions set by the requesting buyer (e.g. language, currency, or vendor location). (Column 5, Lines 9-12).

For example, a buyer who specifies vendors of volt meters in New York State will reach more vendors than if New York City alone were specified. Such class specifications are information filters through which only the desired vendors can pass. (Column 7, Lines 9-14).

Although, *Giovannoli* discloses a potential condition of language set by the requesting buyer and a population comparison between New York State and New York City, *Giovannoli fails to disclose that the condition of language is associated in anyway with determining a geographic location or that the population comparison is in anyway associated with generating a custom global content directory having pointers identifying seller databases*. Thus *Giovannoli* cannot provide for an “**electronic commerce system applying dynamic database redirection**” or even “**generat[ing] custom global content directories where the pointers identify seller databases in the languages corresponding to the geographic location of the one or more buyers**”, since *Giovannoli* does not even provide for a condition of language associated with the user geographical location in the first place. In addition, *Giovannoli* cannot provide for “**providing multi-language support based upon the geographic location of the one or more buyers**”, since *Giovannoli* does not even provide for multi-language support in the first place.

The Office Action has Failed to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Jammes-Giovannoli* Combination

The Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Jammes* and *Giovannoli*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Jammes* and *Giovannoli* as proposed. In fact, ***the Office Action is silent as to why it would have been obvious to one having ordinary skill in the art at the time the invention was made to use Giovannoli to overcome the acknowledged shortcomings in Jammes.*** (23 May 2006 Final Office Action, Page 9).

However, the Examiner asserts that the motivation to combine *Jammes* and *Giovannoli* would be “to allow the buyers to choose sellers from locations that would be preferable from delivery and shipping cost points of views” and “to expand business into foreign countries, resulting in increase of revenue and profits for sellers.” (23 May 2006 Final Office Action, Page 9). The Applicant respectfully disagrees and further respectfully submits that the reasoning relied on by the Examiner for combining the references are nowhere disclosed, taught, or suggested in *Jammes* or *Giovannoli*, either individually or in combination. The Applicant further submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention***, and that ***any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, ***the Examiner has not adequately supported the selection and combination of Jammes or Giovannoli to render obvious the Applicant's claimed invention.*** The Examiner's conclusory statements that the motivation to combine

Jammes and *Giovannoli* teachings would be “to allow the buyers to choose sellers from locations that would be preferable from delivery and shipping cost points of views” and “to expand business into foreign countries, resulting in increase of revenue and profits for sellers”, **does not adequately address the issue of motivation to combine**. (23 May 2006 Final Office Action, Page 9). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to “[use] that which the inventor taught against its teacher.” *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, **the Office Action fails to provide proper motivation for combining the teachings of *Jammes* or *Giovannoli***, either individually or in combination.

The Proposed *Jammes-Etten* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant’s Dependent Claim 5

For example, with respect to amended dependent claim 5, this claim recites:

The system of Claim 1, wherein **the search query comprises desired values, specified by the one or more buyers**, for one or more of the product attributes associated with the selected product class. (Emphasis Added).

Amended dependent claims 16 and 27 recite similar limitations. *Jammes* or *Etten*, either individually or in combination, fail to disclose each and every limitation of amended dependent claims 5, 16, and 27.

The Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that *Jammes* fails to disclose the emphasized limitations noted above in amended dependent claim 5. Specifically the Examiner acknowledges that *Jammes* fails to disclose an “**electronic commerce system applying dynamic database redirection**” wherein “**the search query comprises desired values, specified by the buyer**, for one or more of the product attributes associated with the selected product class.” (23 May 2006 Final Office Action, Page 11). However, the Examiner asserts that the cited portion of *Etten* disclose the acknowledged shortcomings in *Jammes*. The Applicant respectfully

disagrees. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in *Etten*.

The Applicant respectfully submits that *Etten* has nothing to do with the amended dependent claim 5 limitations regarding an “**electronic commerce system applying dynamic database redirection**” and in particular *Etten* has nothing to do with amended dependent claim 5 limitations regarding the electronic commerce system “wherein **the search query comprises desired values, specified by the one or more buyers**, for one or more of the product attributes associated with the selected product class.” Rather, *Etten* describes a procurement system for special item purchases that are not found when searching a catalog database. (Abstract). The Applicant directs the Examiner's attention to the cited portions of *Etten*, relied upon by the Examiner:

[0031] Once a leaf class is selected, a parametric search engine is presented as shown at point 94. The parametric search engine presents the attributes associated with a specific item leaf class and valid values associated with each attribute. The attributes can be presented in a variety of selection objects, such as drop-down boxes, list boxes, and sets of check boxes as shown in the example of FIG. 6. The user selects the value and clicks an operator button. Within the Parametric Search, there is an undo button that removes the value in the search for items.

Etten fails to disclose that this parametric search engine provides the ability to communicate a search query to a seller database specified by a buyer for one or more of the product attributes associated with the selected product class. In fact, the parametric search engine cited by the Examiner in *Etten*, is actually associated with selection objects, such as predetermined drop-down boxes and is not in anyway associated with, or related to, the search interface operable to communicate a search query to the seller databases in the subject Application. Thus *Etten* cannot provide for an “**electronic commerce system applying dynamic database redirection**” or even the electronic commerce system “wherein **the search query comprises desired values, specified by the one or more buyers**, for one or more of the product attributes associated with the selected product class”, since *Etten* does not even provide for a search interface operable to communicate a search query to the seller databases in the first place.

The Office Action has Failed to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Jammes-Etten* Combination

The Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Jammes* and *Etten*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Jammes* and *Etten* as proposed. In fact, ***the Office Action is silent as to why it would have been obvious to one having ordinary skill in the art at the time the invention was made to use Etten to overcome the acknowledged shortcomings in Jammes.*** (23 May 2006 Final Office Action, Page 11).

However, the Examiner asserts that the motivation to combine *Jammes* and *Etten* is that “the use of the class/attribute/value approach permits a comparison of multiple items that meet the parametric search criteria and the selection of the item that meets the buyer’s specific requirements.” (23 May 2006 Final Office Action, Page 11). The Applicant respectfully disagrees and further respectfully submits that the reasoning relied on by the Examiner for combining the references are nowhere disclosed, taught, or suggested in *Jammes* or *Etten*, either individually or in combination. ***The Applicant respectfully requests the Examiner to point to the portions of Jammes or Etten which contain the teaching, suggestion, or motivation to combine Jammes or Etten for the Examiner’s stated purported advantage.*** The Applicant further submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention***, and that ***any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to

the subject Application, ***the Examiner has not adequately supported the selection and combination of Jammes or Etten to render obvious the Applicant's claimed invention.*** The Examiner's conclusory statements that the motivation to combine *Jammes* and *Etten* teachings is that "the use of the class/attribute/value approach permits a comparison of multiple items that meet the parametric search criteria and the selection of the item that meets the buyer's specific requirements", ***does not adequately address the issue of motivation to combine.*** (23 May 2006 Final Office Action, Page 11). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office Action fails to provide proper motivation for combining the teachings of Jammes or Etten***, either individually or in combination.

The Applicant's Claims are Patentable over the Proposed *Jammes-Giovannoli-Etten* Combination

As mentioned above, amended independent claims 1, 10, 21, and 32 are considered patentably distinguishable over *Jammes*, *Giovannoli*, and *Etten*. With respect to dependent claims 2-9, 11-20, and 22-31: claims 2-9 depend from amended independent claim 1; claims 11-20 depend from amended independent claim 10; and claims 22-31 depend from amended independent claim 21. As mentioned above, each of independent claims 1, 10, 21, and 32 are considered patentably distinguishable over the proposed combination of *Jammes*, *Giovannoli*, and *Etten*. Thus, dependent claims 2-9, 11-20, and 22-31 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicant submits that claims 1-32 are not rendered obvious by the proposed combination of *Jammes*, *Giovannoli*, and *Etten*. The Applicant further submits that claims 1-32 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of claims 1-32 under 35 U.S.C. § 103(a) be reconsidered and that claims 1-32 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.*** Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations.*** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, ***and not based on applicant's disclosure.*** *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability,*** and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:


In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

A Request for Continued Examination (RCE) is being filed in duplicate concurrently herewith to facilitate the processing of this deposit account authorization. **The Commissioner is hereby authorized to charge the RCE Fee of \$790.00 to Deposit Account No. 500777.** Because this Amendment is filed prior to the ending of the response period 23 August 2006 of the Final Office Action mailed on 23 May 2006, no additional fees are deemed to be necessary; however, the undersigned hereby authorizes the Commissioner to charge any additional fees that may be required, or credit any overpayments, to **Deposit Account No. 500777.**

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

8/11/06
Date


James E. Walton, Registration No. 47,245
Steven J. Laureanti, Registration No. 50,274
Daren C. Davis, Registration No. 38,425
Michael Alford, Registration No. 48,707
Law Offices of James E. Walton, P.L.L.C.
1169 N. Burleson Blvd., Suite 107-328
Burleson, Texas 76028
(817) 447-9955 (voice)
(817) 447-9954 (facsimile)
steven@waltonpllc.com (e-mail)

CUSTOMER NO. 53184

ATTORNEYS AND AGENTS FOR APPLICANT